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29200	7590	10/18/2007		
BAXTER HEALTHCARE CORPORATION			EXAMINER	
1 BAXTER PARKWAY			MULLIS, JEFFREY C	
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DEERFIELD, IL 60015			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/917,136  
Filing Date: July 27, 2001  
Appellant(s): SHANG ET AL.

**MAILED**  
**OCT 18 2007**  
**GROUP 1700**

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Robert Barrett  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6-18-07 appealing from the Office action  
mailed 1-22-07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of the claimed subject matter contained in the brief is substantially correct. The summary is clearly and correctly mapping the limitations of the sole independent claim 145, not cancelled claim 32. Reference to canceled claim 32 is clearly a typographical error.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,743,523	Woo et al.	6-2004
6,969,483	Woo et al.	11-2005

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-19 and 145-161 are rejected under 35 U.S.C. 102(e) as being anticipated or in the alternative obvious by Woo et al. (US 6,743,523).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The instant claim recite that the second component "free of crosslinking", a disclosure not supported by the parent and therefore the effective filing date of the instant case is the actual filing date, 7-27-01. Additionally the dependent claims recite use of 4-methylpentene-1 (at least claim 16) and 75% first component (at least claim 19), features not present in the parent case.

Woo et al. in the examples 2-10 at column 10, (including the Table at lines 46 et seq) disclose a "monolayer" film crosslinked by electron beam radiation having applicants amounts of polypropylene (PP3505GE1) and polyethylenes such as Engage 8003 or Affinity PL-1880. Appellants' examples and patentees' are identical and hence reasonably appear to share characteristics.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently

possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

**(10) Response to Argument**

The filing date of the instant claims is 7-27-2001 since a single embodiment is not sufficient to support the full scope of the claims which recite various genuses and ranges. Applicants parent case (09/526357) of which the present case is a CIP, does not support all crosslinked compositions, just an example or two. On the other hand even a single embodiment reading on a claim such as Woo ('523) discloses is sufficient to meet the requirements of anticipation. There is nothing inconsistent in the examiners position that the identical disclosure of Table 2 (present in both Woo '523 and '483) anticipate the claims but fails to support a filing date of 3-16-2000.

Appellants argue "the currently pending application has the priority date of the Parent with respect to the information found in (Table 2)". However the instant claims are not limited to the information in Table 2. Were a claim present in the instant case limited to the particulars of Table 2 (including specific processing used to result in crosslinking of component "1" but not "2") of the present application (which is indeed identical to the Table found in columns 11-12 of the parent case US 6,969,483) then those claims would be allowable over the art of record as the filing date of such claims would be that of the parent, 3-16-2000. However, MPEP 2163.03, section II permits benefit of an earlier filing date where the subject matter of the claim is disclosed in the

manner provided by 35 USC 112, first paragraph in an earlier application. Nothing in MPEP 2163.03 provides benefit for specific embodiments of one claim which is supported by a parent and not for other specific embodiments of that claim which are not supported. Thus, failure of the parent to support the full scope of a claim would mean that the effective filing date of that claim would be the actual filing date of the instant case, 7-27-01. Woo et al., which has a different inventive entity than the instant case, has a filing date of 3-16-2000 and is therefore prior art under 35 USC 102(e). Applicants point out that MPEP requires express, inherent or implicit support by a parent. However given that there are no examples of use of methyl pentene and that in order to produce a monolayer film one would have to select a specific isomer of methyl pentene, comonomer, as well as type of process for crosslinking and in the case of radiation crosslinking also select a radiation dosage. Therefore, it cannot be said that there is any specific result which is inherent in connection with methyl pentene usage and for this reason alone it cannot be said to be true that the parent case supports the present case. Selecting from various choices in a disclosure and combining them is not the sort of argument on which inherency can be said to be based. It is noted that the examiners argument re propylene polymers relies on the examples in the Table starting at the bottom of column 10 (identical to Table 2 of the present case). These examples are highly specific re the above discussed factors and require no selection from various disclosures and combining them to achieve any inherent characteristic.

Appellants also argue in section "2" that the present claims are fully supported by the parent. However, the parent case as filed does not disclose that "the second

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component is not crosslinked". That limitation was introduced *ipsis verbis* upon filing of the present CIP and there is nothing in the disclosure of the parent case that would lead those skilled in the art to conclude that all embodiments of claim 145 were not crosslinked or how to achieve a composition in which component "2" was not crosslinked. In fact appellants' examples of cycloolefin monomers used to produce the second component as set out at column 7, line 60-column 8, line 13 include materials such as cycloheptadiene as well as other cyclic dienes such as those skilled in the art understand produces polymers with residual unsaturation. Note also unsaturated substituents such as "(meth)acryloxy" etc at column 8, lines 1-13, use of which would result in polymers with pendant unsaturation. Introduction of unsaturation into polymers is often (if not largely) used to provide means for crosslinking and those skilled in the art would assume that exposure to crosslinking conditions such as are required by both Woo patents would result in at least a slight amount crosslinking. The fact that cycloolefin monomer containing polymers no longer are present in the claims are immaterial since those skilled in the art would be led away from the conclusion that all second component materials (including those that are claimed) do not crosslink. Furthermore the term "propylene containing polymers" as recited by claim 145 encompasses the well known EPDM polymers (ethylene-propylene-diene monomer) which contain diene and are generally crosslinked in the art via diene moiety when used. Again, it is noted that methyl pentene polymers are not represented at all in Table 2. Finally, it is noted that a variety of conditions including radiation levels not used in the table and chemical means for crosslinking are disclosed at column 9, lines 40-60 of the



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parent case and those skilled in the art could not even conclude that the specific materials of component "2" in Table 2 would not crosslink given use of different crosslinking conditions such as different radiation doses or different amounts/types of crosslinkers etc. Thus implicit and express support is also lacking for appellants' limitation that the second component is not crosslinked.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey Mullis

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Jeffrey Mullis



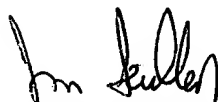
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